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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,408	01/16/2004	Matthew E. Blauch	HES 2000-IP-002053U1	7483

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EXAMINER

COY, NICOLE A

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/759,408	Applicant(s) BLAUCH ET AL.	
	Examiner Nicole Coy	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 18-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1-16/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to a method, classified in class 166, subclass 300.
 - II. Claims 18-32, drawn to a composition, classified in class 507, subclass 266.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the composition can be used as a cleaning product outside of a well.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Craig Roddy on October 5, 2005 a provisional election was made without traverse to prosecute the invention of I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-32 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7-9, and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/02698.

With respect to claim 1, WO 01/02698 discloses a method of servicing a wellbore in a subterranean formation, comprising: (a) providing a wellbore servicing fluid comprising an additive for removing a filter cake from a face of the subterranean formation; and (b) contacting the filter cake with the additive to thereby remove the filter cake (see page 3 lines 9-14 and page 1 line 21).

With respect to claim 2, WO 01/02698 discloses the removal of the filter cake and the servicing of the wellbore in situ (see page 4 line 4).

With respect to claim 3, WO 01/02698 discloses a wellbore which extends in the horizontal direction (see page 13 line 23).

With respect to claim 4, WO 01/02698 discloses a wellbore servicing fluid comprising gravel suspended therein, wherein the gravel is deposited in the wellbore concurrent with the removal of the filter cake (See page 14 lines 20-21).

With respect to claim 7, WO 01/02698 discloses an additive that is an oil-soluble compound that undergoes hydrolysis in the wellbore to produce an acid. See page 3 lines 9-14 and page 4 lines 20 and 21, wherein a mutual solvent is inherently oil-soluble.

With respect to claim 8, WO 01/02698 teaches an acid which dissolves particulates in the filter cake (see page 16 lines 29-30; page 3 lines 20-21).

With respect to claim 9, WO 01/02698 teaches that particulates comprise calcium carbonate (see page 16 lines 29-30).

With respect to claim 12, WO 01/02698 teaches an additive which undergoes hydrolysis when it contacts water provided from water in the wellbore servicing fluid, connate water in the subterranean formation, water in the filter cake, water produced by the subterranean formation, water pumped into the wellbore, or combinations thereof (see page 3 lines 9-14).

With respect to claim 13, WO 01/02698 teaches an additive which comprises organic anhydrides, glycols, esters, or combinations thereof (see page 3 line 23).

With respect to claim 14, WO 01/02698 teaches a wellbore servicing fluid further comprising a polymer breaker (see page 14 lines 15-16).

With respect to claim 15, WO 01/02698 teaches an amount of additive present in the wellbore servicing fluid ranging from 0.1 % to about 26% by total weight of the fluid (see page 4 line 26).

4. Claims 1, 4, 5, 6, 16, and 17 are rejected under 35 U.S.C. 102(a) as being anticipated by Parlar et al. (USP 6,631,764).

With respect to claim 1, Parlar et al. discloses a method of servicing a wellbore in a subterranean formation, comprising: (a) providing a wellbore servicing fluid comprising an additive for removing a filter cake from a face of the subterranean formation; and (b) contacting the filter cake with the additive to thereby remove the filter cake (see column 2 lines 48-50 and lines 66-67).

With respect to claim 4, Parlar et al. discloses a wellbore servicing fluid comprising gravel suspended therein, wherein the gravel is deposited in the wellbore concurrent with the removal of the filter cake (see column 2 lines 35-42).

With respect to claim 5, Parlar et al. discloses a wellbore servicing fluid selected from the group consisting of an oil-based fluid, an invert emulsion fluid, and a reversible emulsion fluid (see column 3 lines 56-58).

With respect to claim 6, Parlar et al. discloses an additive dissolved in an oil phase of the wellbore servicing fluid (see column 7 lines 35-40).

With respect to claim 16, Parlar et al. discloses gravel present in the wellbore servicing fluid which ranges from about 0.1 to about 15 pounds of gravel/gallon of the fluid (see column 5 lines 15-18).

With respect to claim 17, Parlar et al. discloses wellbore servicing fluid which comprises from about 30% to about 50% oil and from about 50% to about 70% water when the fluid is an invert emulsion fluid or reversible emulsion fluid, all weight percentages being by total weight of the wellbore servicing fluid (see column 8 table 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/02698 in view of Patel (USP 5,888,944).

With respect to claim 10, WO 01/02698 teaches that filter cakes are formed. See page 1 line 21. However, WO 01/02698 is silent as to the particular method by which the filter cake is formed. However, forming filter cakes from a reversible water-in-oil emulsion is well known in the prior art. For example, Patel teaches a method of removing a filter cake from a wellbore which includes drilling the wellbore with a novel invert emulsion drilling mud in which the emulsion can be converted from a water-in-oil type emulsion to an oil-in-water type emulsion. See column 2 lines 60-64. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify WO 01/02698 by forming the filter cake from a reversible water-in-

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oil emulsion as taught by Patel, as this type of emulsion is commonly used to form filter cakes.

WO 01/02698 teaches that in some circumstances the use of an emulsion of an ester may be desirable. See page 11 lines 31-32. However, WO 01/02698 is silent as to what those types of emulsion are. However, Patel teaches a method of removing a filter cake from a wellbore which includes drilling the wellbore with a novel invert emulsion drilling mud in which the emulsion can be converted from a water-in-oil type emulsion to an oil-in-water type emulsion. See column 2 lines 60-64. Patel also teaches that the acid utilized to break the invert emulsions of the present invention include hydrolysable esters. See column 5 lines 48-66. Patel teaches that the emulsion is converted in order to decrease the number of steps involved in removing the filter cake and cleaning up the well while minimizing the risk of well collapse. See column 2 lines 44-49. It would have been obvious to modify WO 01/02698 by converting the reversible water-in-oil emulsion of the filter cake to an oil-in-water emulsion as taught by Patel in order to decrease the number of steps involved in removing the filter cake and cleaning up the well while minimizing the risk of well collapse.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 8:00-5:30, 1st F off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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William Neuder
Primary Examiner